

REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed July 10, 2008. Claims 4-31 were pending in the present application. This Amendment amends claims 4, 7, 13, 18, 20, and 30, and cancels claim 8 without prejudice, leaving pending in the application claims 4-7 and 9-31. Applicant submits that no new matter has been introduced by virtue of these amendments. Reconsideration of the rejected claims is respectfully requested.

35 U.S.C. §112 Rejections of Claims 7-16, 18, 19, 21, 22, 24-28, 30, and 31

Claims 7-16

Claims 7-16 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action asserts “claims 7-16 [provide] for the use of scalability, but, since the [claims do] not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.” (Office Action: pg. 2). Applicant respectfully traverses.

Claims 7-16 depend (either directly or indirectly) from independent claim 4, which clearly recites a method comprising positive steps. For example, claim 4 recites, in part, “providing a web-based system...” and “sharing, via the web-based system, the plurality of data...” Since claims 7-16 incorporate claim 4 by reference, claims 7-16 necessarily include all of the steps of claim 4: “Claims in dependent form shall be construed to include all of the limitations of the claim incorporated by reference into the dependent claim.” (MPEP §608.01(n); emphasis added).

Accordingly, Applicant submits that claims 7-16 do set forth steps involved in a method/process, and respectfully requests that the Section 112 rejection of these claims be withdrawn.

Claim 10

Claim 10 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action asserts “the term ‘incrementally’ in claim 10 is a relative term which renders the claim indefinite. The term ‘incrementally’ is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.” (Office Action: pgs. 2-3). Applicant respectfully traverses.

As is well-known, when a process/action is performed “incrementally,” it is performed “in increments,” or “not all at once.” Thus, one of ordinary skill in the art would readily appreciate that the portion of claim 10 that recites this term – *i.e.*, “wherein the plurality of modules are purchased incrementally” – indicates that the plurality of modules are purchased in increments, or not purchased all at once.

Contrary to the Office Action, whether a process/action is performed incrementally is not a question of degree. Either the process/action is performed in increments, or it is not performed in increments; there is no middle ground.

It is true that, when a process/action is performed incrementally, the size and/or timing of each increment may vary. However, adding additional limitations to claim 10 pertaining to increment size or timing would only serve to narrow, rather than clarify, the claim. On this issue, the MPEP states “breadth of a claim is not to be equated with indefiniteness... If the scope of the subject matter embraced by the claims is clear... then the claims comply with 35 U.S.C. §112, second paragraph.” (MPEP §2173.04; emphasis added). In the present case, claim 10 clearly covers the purchase of modules in increments, regardless of the size/timing of each increment.

For at least the foregoing reasons, Applicant submits that claim 10 is definite under Section 112, second paragraph, and respectfully requests that the Section 112 rejection of this claim be withdrawn.

Claim 13

Claim 13 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action asserts “the term ‘similar’ in claim 13 is a relative term which renders the claim indefinite. The term ‘similar’ is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Examiner is unsure if similar means 99% the same, 90% the same, or 20% the same.” (Office Action: pg. 3).

Although Applicant does not necessarily agree with the rejection, solely in order to expedite prosecution claim 13 has been amended to recite, in part, “wherein the at least one generic tool is adapted to function in a substantially similar manner in each of the plurality of modules.” (Emphasis added). Support for this amendment may be found in the Specification at, for example, paragraph 73.

Applicant submits that the phrase “substantially similar” is definite under Section 112, second paragraph, because one of ordinary skill in the art would readily understand its meaning in view of the Specification. For example, the Specification identifies examples of generic tools, such as “hotlist, followup, report and search” and states that these tools “function in a substantially similar manner in each of the modules in which it is deployed.” (Specification: para. 73; emphasis added). The Specification goes on to describe various modules and how these generic tools are deployed therein. (See Specification: paras. 77, 107-110, 118-128). Based on this description, one of ordinary skill in the art would be reasonably apprised of the scope of the “substantially similar” language in claim 13. Accordingly, Applicant submits claim 13 (as amended) is definite under Section 112, second paragraph, and respectfully requests that the Section 112 rejection of this claim be withdrawn.

Claims 18 and 19

Claims 18 and 19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicant regards as the invention. In particular, the Office Action asserts “it is not clear from the claims who are the first and second parties to differentiate from the claimed ‘third party.’” (Office Action: pg. 3).

Although Applicant does not necessarily agree with the rejection, solely in order to expedite prosecution claim 18 has been amended to recite, in part, “wherein the web-based system is deployed on a portal hosted by a hosting service provider.” (Emphasis added). Support for this amendment may be found in the Specification at, for example, paragraph 61. Since the phrase “third-party” has been removed, Applicant submits that the Section 112 rejection of claims 18 and 19 is overcome, and respectfully requests that the rejection be withdrawn.

Claims 21, 22, 24-28, 30, and 31

Claims 21, 22, 24-28, 30, and 31 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action asserts “the claims are understood to be the intended use of the described structure without the introduction of additional elements. As the intended use of an element has no patentable weight, these claims may or may not be performed. Additionally, the lack of structure brings up the confusion as to the correct statutory class.” (Office Action: pgs. 3-4). Applicant respectfully traverses.

As best understood from the above, the Office Action apparently construes claims 21, 22, 24-28, 30, and 31 as lacking any structural features of a system. However, claims 21, 22, 24-28, 30, and 31 depend (either directly or indirectly) from independent claim 20, which clearly recites such features. For example, claim 20 recites, in part, “at least one database,” “at least one server,” and “at least one client.” Since claims 21, 22, 24-28, 30, and 31 incorporate claim 20 by reference, claims 21, 22, 24-28, 30, and 31 necessarily include all of the structural features of claim 20: “Claims in dependent form shall be construed to include all of the limitations of the claim incorporated by reference into the dependent claim.” (MPEP §608.01(n); emphasis added).

Accordingly, Applicant submits that claims 21, 22, 24-28, 30, and 31 do set forth structural features of a system, and respectfully requests that the Section 112 rejection of these claims be withdrawn.

Claim 30

Claim 30 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action asserts “the claim uses the term ‘remember,’ to describe a computer based activity. The Examiner notes that remember refers to the mind of a person, or re-mind-er. The Examiner understands that this claim means that the database stores information.” (Office Action: pg. 4).

Although Applicant does not necessarily agree with the rejection, solely in order to expedite prosecution claim 30 has been amended to recite “store” rather than “remember.” Applicants submits that this amendment clarifies that the database is adapted to store the current state of the plurality of views. Accordingly, Applicant submits that the Section 112 rejection of claim 30 is overcome, and respectfully requests that the rejection be withdrawn.

35 U.S.C. §101 Rejection of Claims 7-19, 21, 22, 24-28, 30, and 31

Claims 7-19, 21, 22, 24-28, 30, and 31 are rejected under 35 U.S.C. §101. In particular, the Office Action states “the 35 U.S.C. §101 statute is included here in support of the 35 U.S.C. §112, second paragraph rejections of claims 7-19, 21, 22, 24-28, 30 and 31 above.” (Office Action: pg. 4). Applicant respectfully traverses.

As an initial matter, Applicant notes that no Section 112 rejection is asserted against claim 17. Further, the Office Action fails to identify any specific deficiency of claim 17 with respect to Section 101. Accordingly, the Section 101 rejection of claim 17 is believed to be in error, and Applicant respectfully requests that the rejection of this claim be withdrawn.

With respect to claims 7-16, 18, 19, 21, 22, 24-28, 30, and 31, the Section 112 rejections of these claims have been overcome as discussed above. Accordingly, to the extent

that the Section 101 rejection of these claims is premised on the previously discussed Section 112 rejections, the Section 101 rejection is also believed to be overcome.

35 U.S.C. §102 Rejection of Claims 4-31

Claims 4-31 are rejected under 35 U.S.C. §102(b) as being anticipated by various pieces of software developed by ZeBU Corporation. In supporting this rejection, the Office Action cites a plurality of documents, which are identified herein as follows: “ZeBulletin, Volume 1, Edition 1,” (hereinafter “ZeBulletin 1”); “ZeBulletin, Volume 2, Edition 1,” (hereinafter “ZeBulletin 2”); and Zebuinc.com Web pages (hereinafter “Zebuinc”). The ZeBulletin 2 reference describes a piece of software known as ZebuNET. The ZeBulletin 1 and Zebuinc references describe a piece of software known as ZeBU AIMSuite (which includes WEB QuickView).

Applicant respectfully traverses the rejection.

Alleged Public Use or Sale

The Office Action states “an issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. §102(b), additional information regarding this issue is required as follows: How the ZeBU product converted later to IIT, is different than the claimed invention.” (Office Action: pgs. 4-5).

As described in the following remarks, the claims of the present invention are substantially different from any of the software described in the cited references. Accordingly, Applicant submits that there is no issue of prior public use or on sale activity under 35 U.S.C. §102(b).

Independent Claim 4

Independent claim 4 (as amended) recites:

A method for facilitating communication among at least one participant in an insurance-underwriting process, the method comprising:

providing a web-based system for storing and organizing a plurality of data related to the insurance-underwriting process, the web-based system adapted to allow

collaboration among the at least one participant via the Internet, the web-based system comprising a first module for creating a case and a second module for tracking the case among the at least one participant after the case has been submitted to a carrier for consideration;

sharing, via the web-based system, the plurality of data among the at least one participant;

wherein the web-based system comprises a multi-layer, modular architecture, the multi-layer modular architecture including a plurality of applications, each application in the plurality of applications including a plurality of modules and employing a desktop visual metaphor for accessing the plurality of modules; and

wherein the at least one participant comprises at least one user, and the web-based system is adapted to restrict the plurality of data accessible to the at least one user based on a plurality of attributes of the at least one user.

(Applicant's independent claim 4, as amended, emphasis added).

As best understood, the Office Action asserts that claim 4 is anticipated by the ZeBU AIMSuite product described in Zebuinc and ZeBulletin 1. Applicant respectfully disagrees. For example, the ZeBU AIMSuite product fails to disclose “providing a web-based system for storing and organizing a plurality of data related to the insurance-underwriting process... the web-based system comprising a first module for creating a case and a second module for tracking the case among the at least one participant after the case has been submitted to a carrier for consideration” as recited in claim 4.

The Office Action asserts that the above feature of claim 4 is shown in the “Zebu HUB,” “AIM DMS,” and “AIM QuickView” sections of Zebuinc. (Office Action: pg. 5). However, Applicant submits that the AIMSuite product, as a whole, is not a web-based system as recited in claim 4. Rather, the AIMSuite software is merely a proprietary client-server product that can operate over public networks such as the Internet. For example, page one of the “Zebu | SelectTech Technology” section of Zebuinc specifically states: “Transmission is instant and compatible to all parties via our proprietary software and Internet HUB.” Thus the AIMSuite cannot be properly construed as a web-based system (*i.e.*, a system that can be operated entirely through a standard web browser), let alone the specific web-based system recited in claim 4.

Applicant notes that page 2 of the “AIM Quickview” section of Zebuinc (as well as ZeBulletin 1) does refer to a “WEB Quickview” application. However, WEB Quickview is merely a tool within AIMSuite that “provides a quick method to view pending data” via the web (rather than via the proprietary client-server interface). (Zebuinc: “AIM Quickview,” pg. 2). WEB Quickview does not provide any other functions, such as creating cases, inputting data, performing administration, *etc.*; it is simply a viewer application. Accordingly, the WEB Quickview component of AIMSuite also cannot be construed as teaching “a web-based system for storing and organizing a plurality of data related to the insurance-underwriting process... the web-based system comprising a first module for creating a case and a second module for tracking the case among the at least one participant after the case has been submitted to a carrier for consideration” as recited in claim 4.

Further, the AIMSuite product fails to disclose “each application in the plurality of applications... employing a desktop visual metaphor for accessing the plurality of modules” as recited in claim 4. The Office Action asserts (with respect to previously presented claim 8) that this feature is shown in ZeBulletin 1 (describing the WEB QuickView component of AIMSuite). (Office Action: pg. 6). Applicant respectfully disagrees.

Although the Office Action does not cite a specific portion of the ZeBulletin 1 reference, the section the Applicant believes the Office Action is referring to states “the new version of AIM Quickview incorporates many of the latest enhancements found on the desktop version of AIM Quickview, in a WEB-enabled thin client application...” (ZeBulletin 1, pg. 1, col. 3). As can be seen, this section merely indicates that the WEB QuickView application includes enhancements included in the “desktop” version of AIM QuickView. The term “desktop” in this context refers to the non-web-based (*i.e.*, proprietary client-server) version of AIM QuickView. This section makes absolutely no reference to a desktop visual metaphor, let alone employing such a visual metaphor to access the modules of a web-based system. Accordingly, the WEB QuickView component of AIMSuite (as described in ZeBulletin 1) fails to disclose “each application in the plurality of applications... employing a desktop visual metaphor for accessing the plurality of modules” as recited in claim 4.

For at least the foregoing reasons, Applicant submits that claim 4 is not anticipated by ZeBU AIMSuite, and respectfully requests that the rejection of claim 4 be withdrawn.

Independent Claim 20

As an initial matter, Applicant submits that the Office Action has failed to establish a prima facie case for an anticipation rejection of independent claim 20 under 35 U.S.C. §102. To establish a prima facie case that a claim is anticipated under 35 U.S.C. §102, it must be established that each and every element of the claim is present in a single reference: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Emphasis added).

In the present rejection, the Office Action cites two separate documents (ZeBulletin 2 and Zebuinc) which describe at least two distinct pieces of software: (1) ZeBUNet (as described in ZeBulletin 2), and (2) ZeBU AIMSuite (as described in Zebuinc). Since the Office Action relies on disclosure pertaining to at least two different pieces of software to reject claim 20 under Section 102 (rather than a single prior art reference), Applicant submits that the Section 102 rejection of this claim is in error and should be withdrawn.

Further, Applicant submits that even if assuming *arguendo* the ZebuNET and ZeBU AIMSuite products were combined, the resultant combination would still fail to teach or suggest all of the features of claim 20. For example, as discussed with respect to claim 4, the AIMSuite product fails to disclose “each application in the plurality of applications... employing a desktop visual metaphor for accessing the plurality of modules” as recited in claim 4. As best understood, the ZebuNET product (as described in ZeBulletin 2) does not provide any teaching that would remedy the deficiencies of AIMSuite in this regard.

For at least these reasons, Applicant submits that independent claim 20 is allowable over the cited art.

Dependent Claims 5-19 and 21-31

Dependent claims 5-19 and 21-31 depend (either directly or indirectly) from independent claims 4 and 20 respectively, and are thus allowable for at least a similar rationale as discussed for claims 4 and 20.

In addition, Applicant submits that claims 5-19 and 21-31 recite additional features that distinguish over the cited art. For example, claim 30 recites, in part “wherein the view-state database is adapted to store the current state of the plurality of views upon log-off of the at least one user.” The Office Action asserts that this feature is shown in the “AIM GA” section of Zebuinc. (Office Action: pg. 12). However, Applicant cannot find any disclosure in this section teaching a view-state database, let alone a view-state database adapted to store the current state of a plurality of views upon log-off of a user as recited in claim 30. Accordingly, Applicant submits that claim 30 is allowable for at least this additional reason.

In rejecting claim 30 (as well as a number of other dependent claims), the Office Action asserts that the features following “adapted to” are “considered the intended use” and thus “have no patentable weight.” (Office Action: pg. 12). Applicant submits that this reasoning is erroneous and contrary to the MPEP and settled case law. For example, section 2111.04 of the MPEP states:

The determination of whether [clauses such as “adapted to,” “wherein” and “whereby” are] a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.”

With respect to claim 30, the feature following “adapted to” recites a characteristic of the view-state database and thus states a condition that is material to patentability. Accordingly, this feature cannot be properly ignored. To the extent that other dependent claims also recite features following “adapted to,” the Examiner is respectfully

requested to accord those features their full patentable weight and perform a full and complete examination.

Amendments to the Claims

Unless otherwise specified, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the Specification as filed and do not add new matter.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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